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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/705,326	08/29/96	LACOUNT	K 1

32M1/1114

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EXAMINER
JONES, E

ART UNIT
3204

DATE MAILED: 11/14/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/705,326	Applicant(s) LaCount et al.	
	Examiner Eugenia Jones	Group Art Unit 3204	
<p><input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Aug 1, 1997</u></p> <p><input type="checkbox"/> This action is FINAL.</p> <p><input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11; 453 O.G. 213.</p> <p>A shortened statutory period for response to this action is set to expire <u>3</u> month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).</p>			
<p>Disposition of Claims</p> <p><input checked="" type="checkbox"/> Claim(s) <u>1-23</u> is/are pending in the application.</p> <p>Of the above, claim(s) <u>6-23</u> is/are withdrawn from consideration.</p> <p><input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p><input checked="" type="checkbox"/> Claim(s) <u>1-5</u> is/are rejected.</p> <p><input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p><input type="checkbox"/> Claims _____ are subject to restriction or election requirement.</p>			
<p>Application Papers</p> <p><input type="checkbox"/> See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.</p> <p><input type="checkbox"/> The drawing(s) filed on _____ is/are objected to by the Examiner.</p> <p><input type="checkbox"/> The proposed drawing correction, filed on _____ is <input type="checkbox"/> approved <input type="checkbox"/> disapproved.</p> <p><input type="checkbox"/> The specification is objected to by the Examiner.</p> <p><input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>			
<p>Priority under 35 U.S.C. § 119</p> <p><input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).</p> <p><input type="checkbox"/> All <input type="checkbox"/> Some* <input type="checkbox"/> None of the CERTIFIED copies of the priority documents have been</p> <p><input type="checkbox"/> received.</p> <p><input type="checkbox"/> received in Application No. (Series Code/Serial Number) _____.</p> <p><input type="checkbox"/> received in this national stage application from the International Bureau (PCT Rule 17.2(a)).</p>			
<p>*Certified copies not received: _____</p> <p><input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).</p>			
<p>Attachment(s)</p> <p><input checked="" type="checkbox"/> Notice of References Cited, PTO-892</p> <p><input checked="" type="checkbox"/> Information Disclosure Statement(s), PTO-1449, Paper No(s). <u>2</u></p> <p><input type="checkbox"/> Interview Summary, PTO-413</p> <p><input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review, PTO-948</p> <p><input type="checkbox"/> Notice of Informal Patent Application, PTO-152</p>			
--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---			

DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of Group I in Paper No. 5 is acknowledged.
2. Claims 6-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 5.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the spring means recited in claim 3 must be shown or the feature(s) cancelled from the claim(s). No new matter should be entered.

Specification

4. The disclosure is objected to because of the following informalities: On page 15, line 25, and page 16, line 7, it appears that "106" should be --105-- since previous references to transfer roller have utilized the numeral "105" (although numeral 105 has also been referred to as "transfer roll assembly") and since the numeral "106" has been referred to as a shaft.

Appropriate correction is required.

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Claim Rejections - 35 USC § 112

5. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 8-10, “drive means...including actuator means operatively connected to said drive means” is confusing and unclear since it seems to recite that the actuator means is part of the drive means but then goes on to recite that the actuator means is connected to the drive means. This makes no sense.

In claim 1, line 13, “the bottom” and “said actuator” lack clear antecedent basis.

Claim Rejections - 35 USC § 102/103

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

a person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Canadian Patent '799.

Canadian Patent '799 discloses a dispenser having all of the structure claimed, as broadly recited, including actuator means (18) operatively connected to drive means for the drive roller (28), wherein the actuator means extends outwardly of the housing and across substantially the entire housing at "the bottom" thereof since from Figure 2 it can be seen that actuator means (18) extends for more than half the distance along the side of the housing. The actuator means includes a bar (18b) exterior to the housing and the dispenser has a bottom portion shaped complimentary to the arc through which the bar moves, see Figure 3; the bar is positioned sufficiently close to the bottom of the dispenser to prevent users from inserting a finger therebetween as can be seen from Figure 3. If it is argued that the actuator means does not extend across "substantially the entire housing", then it would have been an obvious matter of

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design choice to provide the actuator means to extend across "substantially the entire housing", since such a modification would have involved a mere change in the size of a component. a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

9. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grunwald.

Grunwald discloses a dispenser substantially as claimed including actuator means (35) operatively connected to drive means for rotating drive roller (31), wherein the actuator means is pivotally mounted on the housing and extends outwardly of the housing across substantially the entire housing since it extends outwardly of plate (25) which forms the front of the housing. Grunwald lacks the actuator means to extend at "the bottom" of the housing. It would have been obvious to one having ordinary skill in the art to at the time the invention was made to provide the actuator means to extend across the housing at "the bottom" thereof, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Palson et al., Austin, Jr., and Perrin et al. show related dispensers with actuator means.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugenia Jones whose telephone number is (703) 308-2172. The examiner can normally be reached on Monday - Thursday from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached on (703) 308-2187. The fax phone number for this Group is (703) 305-3579.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [\[rinaldi.rada@uspto.gov\]](mailto:rinaldi.rada@uspto.gov).

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.



EAJ

November 7, 1997

EUGENIA JONES
PRIMARY EXAMINER
GROUP 3200